

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT O. SANTOS

Appeal No. 97-1092
Application 08/412,491¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, STAAB
and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Robert O. Santos appeals from the final rejection of claims 1 and 4 through 7. Claims 8 through 14, the only other claims pending in the application, stand objected to as

¹ Application for patent filed March 28, 1995.

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depending from a rejected base claim.

The subject matter on appeal relates to "a three-way valve for a faucet head" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. A kitchen faucet comprising:

a) a kitchen faucet base having an temperature control valve and a hollow member extending therefrom;

b) an extensible kitchen faucet head, said extensible kitchen faucet head connectable to the kitchen faucet base and including a flexible conduit sized to slide in and out of the hollow member, said flexible conduit connectable to a source of liquid, said extensible kitchen faucet head further comprising a kitchen faucet body having;

i) a first passageway therein, an inlet of said first passageway connected to said flexible conduit, said first passageway diverging into a second and a third passageway, each of said second and third passageways having an outlet for liquid discharge; and

ii) means for blocking flow of said liquid through one of and both of said second and third passageways.

The references relied upon by the examiner as evidence of obviousness are:

Magnenat et al. (Magnenat)	5,158,234	Oct. 27, 1992
Henkin et al. (Henkin)	5,230,106	Jul. 27, 1993

Claims 1 and 4 through 7 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Magnenat in view of Henkin.

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Reference is made to the appellant's main and reply briefs (Paper Nos. 11 and 13) and to the examiner's main and supplemental answers (Paper Nos. 12 and 14) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

Magnenat, the examiner's primary reference, discloses an extensible kitchen faucet comprising a mixer housing 1, a control lever 2, a spout 3, a flexible water conduit 4, a handle 5 and a head 11 (see Figure 1). As described by Magnenat,

[t]he head 11 . . . comprises a body 15 . . . and comprises fixing means, generally a threading, for the flexible conduit 4. This upstream end comprises a water entry chanel [sic] 18, opening into a first chamber 19. This first chamber 19 is connected by means of a passage 20 to a second chamber 21, also located in the body 15 of the head 11.

The lower face of the body 15 of the head 11 comprises two outlets openings 24, 25, preferably having the same diameter, provided with a threading permitting fixing an aerator 22 or a shower head 23 therein. . . .

The body 15 comprises further a wall 26 separating the outlet aperture 25 of the first

chamber 19, wall 26 being with an opening 27 of a diameter approximately equal to that of the passage 20 connecting the chambers 19 and 21.

An obturation member, here a flap 28, is pivotally mounted in the body 15 by means of a shaft 29 Each of the faces of the flap 28 bears a gasket 31, 32. In a first position of the flap shown in FIG. 2, the gasket 32 surrounds the opening 27 and effects a tight closure between the first chamber 19 and the outlet aperture 25. In this first position of the flap 28 the passage 20 is free and water flows from the first chamber 19 into the second chamber through the passage 20 to come out through the aperture 24.

In a second position of the flap 28, the gasket 31 surrounds the upstream end of the passage 20 and obturates it in a tight manner so that the water flows out of the first chamber 19 through the outlet aperture 25 directly. . . .

The head comprises further an actuating member 35 presenting the shape of a stirrup the arms of which are fast with . . . the shaft 29 of the flap for its actuation [column 3, line 42 through column 4, line 24].

As acknowledged by the examiner (see page 5 in the main answer), the Magnenat faucet does not meet the limitation in independent claim 1 requiring "means for blocking flow of said liquid through one of and both of said second and third passageways." In this regard, Magnenat's flow blocking means (flap 28) is adapted to block the flow of liquid through one or the other of the passageways leading to the outlets, but

not both.

Henkin discloses a hand-held, water massage apparatus designed to discharge water through different sets of openings in a continuous shower spray, a pulsed shower spray or a hydromassage stream. A control knob 130 on the apparatus

operates a valve 190, best shown in Figures 10 through 12, to select any one of the foregoing operational modes or an OFF mode (see column 6, line 32 et seq.).

According to the examiner,

[i]n view of the teaching of Henkin et al, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the faucet valve of Magnenat et al to include the faucet head of Henkin et al to provide a faucet head containing a first and second outlet producing a stream or spray flow stream and means to block fluid flow through one or both of the outlets [main answer, page 5].

Even if Henkin is analogous art (the appellant argues that it is not), the combined teachings of Magnenat and Henkin do not justify the examiner's conclusion of obviousness. The water discharge devices disclosed by these references differ substantially in structure and intended use. The only

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suggestion for combining such disparate structures in the manner proposed by the examiner stems from an impermissible hindsight reconstruction of the appellant's invention wherein the claims have been used as a template to selectively piece together isolated disclosures in the prior art.

This being the case, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or of dependent claims 4 through 7, as being unpatentable over Magnenat in view of Henkin. The following new rejections are entered pursuant to 37 CFR § 1.196(b).

Claim 1, and claims 4 through 14 which depend therefrom, are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to comply with the written description requirement of this section of the statute.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the

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artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). In the present case, the disclosure of the application as originally filed would not reasonably convey to the artisan that the appellant had possession at that time of a kitchen faucet comprising a "temperature control valve" and a "flexible" conduit as is now recited in independent claim 1.

Claim 1, and claims 4 through 14 which depend therefrom, also are rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In determining whether this standard is met, the definiteness of the language employed in the claims must be analyzed, not

in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id. Here, the recitation in independent claim 1 of a faucet having "an extensible kitchen faucet head" is inconsistent with the underlying disclosure which indicates that it is the faucet as a whole, rather than the faucet head component thereof, which is extensible (see, for example, Figure 7 and specification pages 2 and 6). This inconsistency renders the scope of claims 1 and 4 through 14 unclear.

In summary:

a) the decision of the examiner to reject claims 1 and 4 through 7 under 35 U.S.C. § 103 is reversed; and

b) new rejections of claims 1 and 4 through 14 are entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203

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Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 37 CFR § 1.196(b)

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Senior Administrative Patent Judge))
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